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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,940	11/06/2000	Richard M. Fike	0942.4290006/RWE/BJD	7464

7590

12/23/2003

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT

PAPER NUMBER

1636

15

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,940

Applicant(s)

FIKE, RICHARD M.

Examiner

David A. Lambertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 15, 16, 18-29, 31-34 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 15, 16, 18-29, 31-34 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Receipt is acknowledged of a reply to the previous Office Action, filed August 12, 2003. Amendments were made to the claims.

Claims 1-10, 15, 16, 18-29, 31-34 and 36-44 are pending and under consideration in the instant application. Any rejection of record in the previous Office Action, mailed February 11, 2003, that is not addressed in this action has been withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 12, 2003 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10, 15, 16, 18-29, 31-34 and 36-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Fike et al. (WO 98/36051, as IDS reference AO4; henceforth Fike; see entire

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document). **This rejection is maintained as set forth in the previous FINAL Office Action mailed February 11, 2003, and is now applied to newly examined claims 40-44.**

Response to Arguments Concerning Claim Rejections - 35 USC § 102

Applicant's arguments filed May 12, 2003 (refilled August 12, 2003 as part of an RCE) have been fully considered but they are not persuasive. Applicant's arguments consist of the following points:

1. Applicant refutes the reference as anticipatory under 35 USC § 102(b) by arguing that the reference does not teach each and every element of the instantly claimed invention, either expressly or inherently. Specifically, Applicant suggests that Fike does not teach either (a) the use of pH-opposing forms of buffer salts, or (b) the determination of the ratio of said pH-opposing forms of buffer salts in the production of an automatically pH-adjusting medium (see pages 5-6 of Applicants response).

Applicant's arguments are not convincing for the following reasons:

1. Fike clearly teaches the use of one or more buffer salts in the production of a nutritive medium (see for example page 20, lines 3-4). Fike further teaches that this nutritive media can be formulated to produce a powdered medium that obviates the need for the subsequent addition of a pH-adjusting agent following reconstitution, thereby producing an "automatically pH-adjusting medium" which avoids the error-prone steps of adding buffer or a pH-adjusting agent to the medium after it is reconstituted (see for example page 20, lines 13-21). In order to avoid the use of a pH-adjusting agent, one would necessarily need to achieve the desired pH through an

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alternative mechanism. It was well known in the art at the time of the invention that the ability to obtain a desired pH could be achieved either by (a) combining a buffer salt and a pH-adjusting agent, or by (b) combining two buffer salts of opposing forms (see for example Gomori, Methods in Enzymology 16: 138-146, 1955; this reference was supplied in response to the After Final amendment filed May 12, 2003, and is not supplied again, although it is now officially cited on a form PTO-892). Thus, in order to avoid the use of a pH-adjusting agent in the formulation of an "automatically pH-adjusting medium," Fike *must inherently* teach the use of pH-opposing forms of buffer salts, and the determination of the ratios of these buffer salts to give a desired pH.

It is clear in MPEP § 2131.01 that extrinsic evidence can be provided to show the inherent characteristics of a primary anticipatory reference. The MPEP explicitly states, "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." As it regards this issue, the position of the Office is that because Fike teaches the use of one or more buffer salts in the production of an "automatically pH-adjusting medium" wherein the use of a pH-adjusting agent is not desirable, Fike *must inherently* teach the use of pH-opposing forms of the aforementioned buffer salts in a particular ratio to achieve the desired pH. This is because the use of more than one buffer is clear in the teachings of Fike, and there is no clear method to achieve a desired pH without the use of either a pH-adjusting agent or pH-opposing buffer salts. The Gomori reference simply teaches the missing inherent property of Fike, whereby one of

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ordinary skill would know how to determine the ratio of pH-opposing forms of buffer salts to obtain a specific pH (the descriptive matter which applicant contends is not inherently taught by the WO 98/36051 reference), and is not to be construed as supplying an element that is completely absent from the teachings of Fike. Thus, the rejection under 35 USC § 102(b) is maintained as inherently teaching the use of pH-opposing forms of buffer salts in an appropriate ratio such that an "automatically pH-adjusting medium" is produced.

Allowable Subject Matter

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson, Ph.D.
AU1636


JAMES KETTER
PRIMARY EXAMINER